



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MARK LEVY & ASSOCIATES PLLC
PRESS BUILDING SUITE 902
19 CHENANGO STREET
BINGHAMTON NY 13901

COPY MAILED

MAR 03 2008

OFFICE OF PETITIONS

In re Application of
Yao, et al :
Application No. 10/782,230 : DECISION ON
Filed: February 19, 2004 : PETITION
Attorney Docket No. RB-176 :
:

This is in response to the petition to revive under 37 CFR 1.137(a), or in the alternative under 37 CFR 1.137(b), filed February 6, 2008.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above-identified application became abandoned for failure to timely pay the issue fee in response to the Notice of Allowance mailed October 3, 2007. This Notice set a statutory period for reply of three months. No issue fee having been received, the application became abandoned on January 4, 2008. The Office mailed a Notice of Abandonment on January 29, 2008.

Petition Under 37 CFR 1.137(a):

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks item (3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."¹

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.²

With regards to item (3), petitioner states that he never received the Notice of Allowance. According to petitioner, the Notice of Allowance was properly mailed to the law firm of Mark Levy & Associates. However, petitioner had transferred responsibility for the instant application to another law firm. Petitioner has included a declaration from Mark Levy, attesting that upon receiving the Notice of Allowance, he forwarded it to petitioner on October 12, 2007. However, petitioner states he never received the Notice of Allowance from Levy.

To establish nonreceipt of an Office action, a petitioner must: (1) include a statement that the Office action was not received; (2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and (3) include a copy of the **docket record** where the nonreceived Office action would have been entered had it been received and docketed.³ A proper docket report consists of a "docket record where the nonreceived Office action would have been entered had it been received and docketed."⁴ "For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket record showing all replies docketed for a date three months from the mail date of the nonreceived Office action

¹ In re Mattulath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

² See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

³ See MPEP 711.03(c)(II).

⁴ MPEP 711.03(c)(II) (emphasis added).

must be submitted..."⁵

With the instant petitioner under 37 CFR 1.137(a), petitioner has not included a copy of his docket records showing where the nonreceived Notice of Allowance would have been entered had it been received and docketed.

Receipt of the fee for the petition under 37 CFR 1.137(a) is acknowledged. The petition fee required for a petition to revive is required for the filing, not merely the grant, of the petition.⁶

Petition Under 37 CFR 1.137(b):

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d).

With the instant petition, petitioner has paid the petition fee, made the proper statement of unintentional delay, and submitted the required reply in the form of the issue fee and form PTOL-85B.

Receipt of the fee for the petition under 37 CFR 1.137(b) is acknowledged.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the

⁵ Id.

⁶ See MPEP 711.03(c)(II)(B).

entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

The application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.



Cliff Congo
Petitions Attorney
Office of Petitions

cc: Steven M. Hoffberg
Milde & Hoffberg LLP
10 Bank Street
Suite 460
White Plains, New York 10606